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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/775,400 | 02/11/2004 | Haojan Lin | Sond 9302 | 8867 |

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J C PATENTS, INC.
4 VENTURE, SUITE 250
IRVINE, CA 92618

EXAMINER

GILBERT, ANDREW M

ART UNIT PAPER NUMBER

3767

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/775,400 | Applicant(s) LIN ET AL. | |
| | Examiner Andrew M. Gilbert | Art Unit 3767 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I: Fig 3 and corresponding claims 1-7 and 9-11 in the reply filed on 2/13/2006 is acknowledged. Claim 8 has been cancelled.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stepping motor must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: On pg 1, paragraph 3, ln 5, the Applicant recites "An elastic convex set plunger (40)"; the Applicant has previously recited "a number of concave recesses (40)" on pg 1, paragraph 3, ln 4. The examiner assumes the elastic convex set plunger is referenced to (42).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 6, 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by McKay (5666947). McKay discloses a gene injection instrument having a pressure chamber (3), a conduit having one end connected to the pressure chamber and a second end that is vented (Fig 4), a throat section (4) narrower than the conduit, the conduit having a convergent inlet (4, 7, Fig 4) and divergent outlet (5; col 4, ln 60-col 5, ln 2), a drug container (6) located above the throat section with a needle tube (Fig 4) located within 15 mm of the center of the throat section (Fig 4), a gas flow from the pressure chamber through the throat section and out of the second end of the conduit (col 4, lns 60-66), and a control system for controlling the gas flow and release of the droplets of drug by changing the pressure of the pressure chamber (col 2, lns 27-37) by means of a stepper motor (11).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broullette et al (2005/0154369). In reference to claims 1-7 and 9-10, Broullette et al discloses a gene injection instrument (10) having a pressure chamber (11), a conduit having one end connected to the pressure chamber and a second end that is vented (Fig 1), a throat section (19) narrower than the conduit, the conduit having a convergent inlet (18) and divergent outlet (20), a drug container (12) with a needle tube (22) located within 15 mm of the center of the throat section (Fig 1), a gas flow from the pressure chamber through the throat section and out of the second end of the conduit (Fig 1), a control system for controlling the gas flow and release of the droplets of drug by changing the pressure of the pressure chamber (paragraph 54), the gas flow being supersonic (paragraph 59, ln 7) and from the group of carbon dioxide, nitrogen, and helium (paragraph 43, ln 5), the pressure in the pressure chamber being between 50-500 psi (paragraph 43, ln 5), the inlet and divergent outlet being symmetrical (Fig 1). However, Broullette et al does not disclose the drug container being located above the throat section. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the drug container located above the throat section because the Applicant has not disclosed that having

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the drug container above the throat section provides an advantage, is used for a particular purpose, or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected the Applicants invention to perform equally well with drug container of Broulette et al because the drug container performs substantially the same function and produces substantially the same result of releasing droplets due to changes in pressure of the pressure chamber. Therefore, it would have been an obvious matter of design choice to modify the location of the drug container to obtain the invention as specified in claim 1.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broulette et al in view of McKay. Broulette et al discloses the invention substantially as claimed except for the control system controlling by means of a stepper motor. McKay teaches that it is known to have a stepper motor for the purpose of controlling the gas supply. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the control system as taught by Broulette et al with the stepper motor as taught by McKay for the purpose of controlling the gas supply.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571) 272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571)272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Andrew Gilbert



MICHAEL J. HAYES
PRIMARY EXAMINER